



Atty Docket No. BOO001/135818

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: M. David Boothe

Serial No.: 09/989,555

Date Filed: 11/20/01

For: MINI-STORAGE DOOR LATCH

Group No.: 3677

Examiner: Carlos Lugo

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Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF UNDER 37 C.F.R. § 1.192

Real Party in Interest

The subject application is owned by Landmark Interest Corporation of Baytown, Texas.

Related Appeals and Interferences

There are no related appeals, and there are no related interferences.

Status of Claims

On February 13, 2004, appellant appealed from the final rejection of claims 9-11, claims 1-8 having been cancelled.

Status of Amendments

There have been no amendments made subsequent to the office action made final November 13, 2003, which is the subject of this appeal.

Summary of the Invention

Applicant's invention comprises a both an apparatus and a method. The apparatus is an improved latching mechanism which facilitates a handicapped person in operating the latching mechanism by allowing a prosthetic arm, hand, finger or other object to easily manipulate it. The latching mechanism is designed to be mounted on a door, gate or similar

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object. The method concerns operating a door having a sliding latch to facilitate use by handicapped or disabled person.

In one embodiment of the invention, a latching mechanism is connected to a door. The latching mechanism includes a latch plate and latch. The latch plate is mounted to the door. The latch plate is cut out in such a way that it not only holds the latch, but also allows the latch to slide within a recess formed between the latch plate and the door. The latch is supported upon a latch plate shelf which is located underneath the latch and which extends from the latch plate to the door.

The latch comprises a bolt, or latch locking piece. The locking piece is extended into a slot or recess in the door frame or wall surrounding the door when the latching mechanism is in the closed position, which prevents the door from being opened. When the latching mechanism is in the open position, the locking piece is retracted from the slot or recess to allow the door to freely be opened.

In addition to the locking piece, the latch also comprises a handle and latch padlock holes. The handle allows a user of normal facility to move the latch from an open position to a closed position, and vice versa. When the latch is in the closed position, the latch holes line up with corresponding holes in the latch plate shelf. Such alignment allows a padlock or similar device to be disposed through both holes preventing movement of the latch by unauthorized individuals.

The latch further comprises a loop hole and loop disposed therein. A handicapped person who lacks the normal ability to grip the latch handle, such as one who suffers from carpal tunnel syndrome, arthritis, or from loss of a limb, can use the loop to move the latch. The loop is designed and arranged so that a disabled person can put a prosthetic arm, hand, finger or other object through the loop and pull the loop. Like the handle, the loop may be used to pull the latch from an open position to a closed position, or from a closed position to an open position. The loop may be constructed of plastic, wire, rope or the like. Further, the

loop is not required to be circular and may have any shape desired or necessary to facilitate a person passing a finger or prosthesis through the loop to move the latch from its open position to its closed position, and vice versa.

Thus, the crux of the invention is to attach a loop adapted for handicapped persons onto a sliding latch. The loop is used both to pull the latch to a closed position and to pull the latch to an open position.

Issues

Are claims 9-11 properly rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 3,078,917 to Recchione in view of U.S. Patent No. 426,389 to Lacey, U.S. Patent No. 6,076,867 to Dollmann et al., or U.S. Patent No. 357,116 to Coultaus?

Are claims 9-11 properly rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,930,563 to Finch et al. in view of U.S. Patent No. 426,389 to Lacey, U.S. Patent No. 6,076,867 to Dollmann et al., or U.S. Patent No. 357,116 to Coultaus?

Grouping of Claims

Claims 9-10 stand or fall together, because claims 9-10 are both directed to an apparatus and include the same essential limitations. Claim 11, a method claim, stands alone.

The Examiner's Rationale

The examiner's rationale for rejecting claims 9-11 as unpatentable over Recchione in view of Lacey, Dollmann or Coultaus, or as unpatentable over Finch in view of Lacey, Dollmann or Coultaus, was stated in his final rejection as summarized below:

Recchione and Finch each disclose a door arranged and designed to roll up and down in a vertical opening of a wall and having a springless latch mechanism. The latch mechanism includes a latch plate mounted on the roll up door, and a latch mounted on the latch plate. The latch is arranged for horizontal movement between an open and a closed position by moving a locking piece into and out of engagement with a slot in the wall.

Although Recchione and Finch fail to disclose that a loop is connected directly to a hole in the latch, Lacey teaches that it is known in the art to have a sliding latch with a hole and a loop directly connected to the latch. Also, Dollmann teaches that it is known in the art to have a sliding latch with a hole and a loop directly connected to the latch, and Coultaus discloses a sliding latch with a hole and a loop.

Argument

The examiner has not established prima facie obviousness to support the § 103(a) rejections. It would not be obvious to one of ordinary skill in the art to combine the Lacey, Dollmann, or Coultaus references with either the Recchione or Finch references, because there is no basis or motivation in the art for combining the references.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). The prior art must suggest the desirability of the combination, *In re Kotzab*, 271 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *In re Mills*, 916 F.2d 680, 26 U.S.P.Q.2d 1430 (Fed. Cir. 1990), and the test of obviousness is whether the combined teachings of prior art, taken as a whole, suggest the combination to the person of ordinary skill in the art. *In re Napier*, 55 F.3d 610, 34 U.S.P.Q.2d 1782 (Fed. Cir. 1995).

For example, in *WMS Gaming Inc. v. International Game Technology*, a patent for a slot machine was held to be valid despite one prior art patent which taught every aspect of the claimed invention except for non-uniform numbers mapping to stop positions to lower the odds of winning. Other prior art patents taught non-uniform numbers mapping to display symbols to simulate physical reels but not to affect the odds, but the court held that there was no evidence of motivation to combine the teachings of the various references. *WMS Gaming Inc. v. Int’l Game Tech.*, 184 F. 3d 1339, 51 U.S.P.Q.2d 1385 (Fed. Cir. 1999).

In the present case under appeal, the examiner has combined either one of two primary references (U.S. Patent No. 3,078,917 to Recchione or U.S. Patent No. 4,930,563 to Finch et al.) which disclose a springless horizontal sliding latching mechanism mounted on a garage door with one of three secondary references (U.S. Patent No. 426,389 to Lacey, U.S. Patent No. 6,076,867 to Dollmann et al., or U.S. Patent No. 357,116 to Coultaus) which disclose a latch with a closing spring and a loop. The combined teachings of cited secondary prior art are to attach a loop to a latch to aid a user of normal facility to open the latch against a spring force which acts to close the latch. The prior art does not teach to use a loop to close a latch, nor to use a loop to aid a handicapped person to manipulate a latch. The state of the art in latch design at the time of applicant's invention is aptly described by six patents which are cited by the examiner in the office actions dated July 16, 2003 and December 19, 2002: U.S. Patent No. 426,389 to Lacey, U.S. Patent No. 6,076,867 to Dollmann et al., U.S. Patent No. 357,116 to Coultaus, U.S. 1,615,120 Patent No. to Fischer, U.S. Patent No. 540,911 to George, and U.S. Patent No. 550,719 to Hudson. These patents are the only cited prior art within the prosecution history of this case which disclose loops.

Lacey teaches attaching a loop to a bolt (A) to aid in the open movement of the bolt (A). U.S. Patent No. 426,389 (issued Apr. 22, 1890), figs. 1-2. However, Lacey teaches to use a spring (G) to move bolt (A) to the closed position. *Id.* at col. 1 ll. 29-31, col. 2 ll. 70-73.

Dollmann discloses a latch (11) having an indirectly coupled ring (29) designed to pull the latch to the open position. U.S. Patent No. 6,076,867 (issued Jun. 20, 2000), figs. 1A-2C. However, Dollmann teaches to use a spring (25), combined with pushing on a locking member surface (22) through an aperture (23) to move the latch from an open position to the closed position. *Id.* at col. 3 ll. 36-67, col. 4 ll. 1-9.

Similarly, Coultaus discloses a bolt which is pulled open by use of loop (G), but which is moved to the closed position by force from a spring (F). U.S. Patent No. 357,116, (issued Feb. 1, 1887), fig. 3, col. 1 ll. 46-49, col. 2 ll. 64-66.

Fischer discloses a door latch having a loop coupled thereto by a cord (3, 10). The loop is used to open the latch against a spring (7') which is designed to close the latch. U.S. Patent No. 1,615,120 (issued Apr. 14, 1922), figs. 1, 3, col. 2 ll. 67-69, col. 3 ll. 34-36.

George teaches using a loop only to help in the open movement of the latch. As clearly indicated, spring bolts (H, B) are used to help in the close movement. U.S. Patent No. 540,911 (issued Jun. 11, 1895), figs. 1-2, 5. "The bolts can be of any of the usual forms having a spring inclosed in the casing, to press the point of the bolt out, an eye or like device being provided on the inner end of the bolt, to attach a cord or chain thereto, to withdraw the bolts from the keepers" *Id.* at col. 2 ll. 77-83.

Hudson teaches only using a loop to help in the open movement of the latch. Hudson discloses a spring metal arm (C) upon the inside of the door operating in an identical manner to George's latch. U.S. Patent No. 550,719 (issued Dec. 3, 1895), fig. 1, col. 1 l. 22, col. 2 l. 62.

In all six disclosures of latches having loops, the latching mechanisms contain springs to effect the closing of the latch. The loops are clearly employed for the sole purpose of aiding an operator to overcome the force of the closing springs. The examiner has failed to cite any prior art where loops are used to close a springless latch. Further, the loops are not structurally designed and arranged for operation by prosthetic limbs. Thus, the state of the art at the time of applicant's invention uses loops only to solve the limited problem of allowing a user of normal facility to comfortably open a latch against a closing spring force. Thus, there is no suggestion either explicit or inherent in the prior art to use a loop with a latch to aid in the closing motion of the latch.

Further, the examiner by his own admission concedes that there is no motivation to combine the Lacey, Dollmann, or Coultaus references with either the Recchione or Finch references to arrive at the present invention of having a loop to aid in the closing motion of a horizontal springless latch, by stating it “would have been obvious...to include...a loop...in order to help in the open movement of the latch,” while remaining conspicuously silent on the issue of using a loop to aid in closing the latch.

In appellant’s Reply to Office Action dated October 9, 2003, the argument that there is no motivation in the art for the examiner to combine the cited references was made. The examiner’s answer was unresponsive, stating “Lacey, Dollmann or Coultaus are used **only** to teach that [sic] is known in the art to have a loop connected directly to a hole in a latch.” (Emphasis in original). The examiner has taken the teachings of prior art out of context by focusing only on those aspects which help his case while ignoring the teachings as a whole. This reasoning is directly contrary to the holding of *Napier* – that the combined teachings of prior art must be considered as a whole in determining whether there is a basis to combine the references. *Napier*, 55 F.3d at 610. More specifically, in determining whether prior references make a claimed invention obvious, the examiner may not simply engage in hindsight reconstruction of the claimed invention, using the inventor’s structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the inventor’s combination would have been obvious. *In re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

Thus, it is clear that the prior art does not suggest the desirability of using a loop to help a user close a latch, nor does the prior art suggest the desirability of using a loop to help a user with a prosthetic limb to operate a latch. The prior art only suggests the desirability of using a loop to aid a user of normal facility to overcome spring force in a latch. Therefore, there is no motivation to combine any of the teachings of Lacey, Dollmann, or Coultaus with either Finch or Recchione.

However, not only is there a lack of basis to combine the cited references, there is actually a disincentive to combine the references. The combined teachings of the prior art taken as a whole actually teach away from the invention and destroy the intended function of the invention. Teaching away from the art is a per se demonstration of lack of prima facie obviousness, *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988), and a § 103(a) rejection which is based upon a modification of a reference that destroys the intent, purpose or function of the invention is improper. *Gordon*, 733 F.2d at 900.

As described above, the prior art teaches that a loop is used with a latch only to allow a user to counteract the closing force of a spring within the latching mechanism in order to move the latch to the open position. The closing movement of the latch is a result only of a compressed spring returning to a relaxed position. Thus, the prior art teaches against using a loop to slide the latch to a closed position. If the inventor adopts the teachings of the cited prior art and uses a spring to close the latching mechanism, the result would frustrate the purpose of the invention – to facilitate for handicapped persons the operation of a door latching mechanism. It would be burdensome for a disabled person to be forced to fight against the force of a stiff spring to open a latch, and if the latch should inadvertently close from the force of the spring, the disabled person may be forced to actuate the latch a greater number of time that would otherwise be the case. Thus, there is a disincentive to combine the teachings of the prior art to arrive at the present invention.

There is no basis, incentive, or motivation contained in the teachings of Lacey, Dollmann, or Coultaus, either explicit or implicit, which supports the combination of these references with the Recchione or Finch references. The examiner has produced no prior art disclosing a latch with a loop, where the loop is used to move the latch to the closed position. The examiner has not made a prima facie case of obviousness.

Summary

Obviousness is not established by a combination of prior art teachings absent some teaching, suggestion, or incentive supporting the combination. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir.1984). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P § 2143.01 (8th ed. rev. 1, Feb. 2003). (Emphasis in original). The prior art does not suggest the desirability of using a loop to help a user close a latch. The prior art does not suggest the desirability of using a loop to help a user with a prosthetic limb to operate a latch. The prior art only suggests the desirability of using a loop to aid a user of normal facility to overcome spring force in a latch. Therefore, it would not be obvious to one of ordinary skill in the art to combine any of the teachings of Lacey, Dollmann, or Coultaus with either Finch or Recchione.

The examiner has failed to meet his burden of presenting prima facie obviousness to support the § 103(a) rejections. For the foregoing reasons, the Appellant submits that the rejections of claims 9-11 are in error, and the Appellant requests the Board of Patent Appeals and Interferences to overturn the rejections.

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APPENDIX A

Claims

9. An improved roll-up door and springless latching mechanism combination for a storage unit,

said roll-up door (10) arranged and designed to roll-up and down in a vertical opening of a wall of said storage unit;

said springless latching mechanism including a latch plate (62) mounted on said roll-up door (10) and a latch (64) slidably mounted on said latch plate (62) and arranged and designed for horizontal movement between open and closed positions by moving a locking piece into and out of engagement with a slot of said wall of said storage unit, characterized in that

a hole is provided in said latch with a loop disposed directly through the hole, said loop being arranged and designed so that a disabled person can put a prosthetic arm, or hand, or finger or other object through the loop and pull said latch from an open position to a closed position and vice versa.

10. A springless latching mechanism for a roll-up door of a storage unit comprising,

a latch plate arranged and designed for mounting on said roll-up door, said latch plate having a cut out, and a horizontal latch plate shelf,

a latch mounted on said latch plate for horizontal movement on said latch plate shelf between open and closed positions, said latch having a portion which extends through said cut out, said portion including a hole with a loop provided therein,

said loop connected directly to said hole such that it is arranged and designed so that a disabled person can put a finger, or hand or prosthetic arm through it and move the loop horizontally without gripping it in order to move the latch between open and closed position.

11. A method of operating a door having a horizontal springless latch mechanism including a latch plate and a sliding latch, said method comprising the steps of,

coupling a loop to said springless latch mechanism, said loop designed and arranged so that a disabled person can put a prosthetic arm, hand, finger, or other object through the loop,

sliding said latch to a closed position by displacing said loop in a first direction, and
sliding said latch to an open position by displacing said loop in a second direction.